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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Zhang et al.
Serial No. : 09/681,483
Filed : April 13, 2001
For : Method and System to Request Remotely Enabled Access
to Inactive Software Options Resident on a Device
Group Art No. : 2135
Examiner : Dada, B.

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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REPLY BRIEF RESPONSIVE TO EXAMINER'S ANSWER
MAILED JANUARY 4, 2007

Dear Sir:

This Reply Brief is being filed in response to the Examiner's Answer mailed January 4, 2007.

REPLY BRIEF

Claims 17, 19-23 stand rejected under 35 U.S.C. §101. Additionally, claims 17, 19, 21-23 and 31 have been rejected under 35 U.S.C. §102(e) as being anticipated by Moeller et al. (USP 6,694,384), and claims 20 and 24-29 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Moeller et al. in view of Applicant's Admitted Prior Art. In the Examiner's Answer mailed January 4, 2007, the Examiner maintained the rejection of claims 17, 19-29, and 31 and dismissed all of the arguments set forth by Appellant in the Appeal Brief of October 2, 2006. In this Reply, Appellant would like to address some of the assertions made by the Examiner.

I. Rejection Under 35 U.S.C. §101

In paragraph (10) **Response to Argument** of the Examiner's Answer, the Examiner rejected arguments previously set forth by the Appellant regarding the rejection of claims 17 and 19-23 under 35 U.S.C. §101. In response to Appellant's argument that claim 17 calls for a statutory process claim, the Examiner stated that "claim 17 is directed to a functional descriptive material (computer program/software) that is embodied is a data signal/carrier wave" and that "a claim reciting a signal encoded with functional descriptive material does not fall within any of the categories of patentable subject matter set forth under 35 USC 101." *Examiner's Answer*, January 4, 2007, p. 7. Appellant disagrees with the Examiner's continued classification of claim 17 as calling for non-statutory subject matter.

Claim 17 calls for a computer data signal process embodied in a carrier wave that represents a sequence of instructions originating from a computer program executed by a computer that causes at least one processor to perform a series of process steps. The process causes the processor to display a GUI configured to facilitate a request over a first communication interface to enable an inactive option resident on a remote device, receive an input of a device identifier, and receive a selection of a usage period. The process further causes the processor to receive a selection of an inactive option for enablement from the GUI, cause a remote centralized processing station to generate a code configured to enable the selected inactive option after successful processing of the received inputs and selections, and transmit the code to the device having the inactive option over a second communication interface different from the first communication interface.

As set forth above, claim 17 calls for a computer implemented process, which falls squarely within an enumerated category of patentable subject matter set forth in 35 U.S.C. §101.

MPEP §2106 states that the Examiner bears the initial burden of setting forth a *prima facie* case of unpatentability. Because a process is recognized as one of the four categories of statutory subject matter, the Examiner, in order to establish a *prima facie* case of unpatentability, must thus show that the process does not have a practical application or provide a useful result. MPEP §2106. Here, the Examiner has not done that. Rather, the Examiner has merely stated that claim 17 “does not fall within any of the categories of patentable subject matter.” However, such is a complete misrepresentation since claim 17 is a “process” claim. As such, the Examiner has failed to meet the initial burden of setting forth a *prima facie* case of unpatentability, as no reasons have been set forth stating why the process of claim 17 does not have a practical application or provide a useful result.

Further, analysis of claim 17 clearly shows that it includes a practical application and provides a useful result. A claim is limited to a practical application when the process, as claimed, produces a concrete, tangible and useful result; i.e., the process recites a step or act of producing something that is concrete, tangible, and useful. MPEP § 2106; *see AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed. Cir. 1999). Claim 17 recites the practical application of a process that causes a processor to perform a series of process steps. The process acts carried out by the processor are a practical application of the process in that they cause the processor to: display a GUI, cause a remote processing station to generate a code, and transmit the code to a device having an inactive option. The process therefore very clearly produces a concrete, tangible, and useful result, and thus, results in a practical application.

In light of the foregoing, Applicant believes that claim 17, and the claims dependent therefrom, are directed to statutory subject matter.

II. Rejection Under 35 U.S.C. §102(e) as Being Anticipated by Moeller et al.

In paragraph (10) **Response to Argument** of the Examiner’s Answer, the Examiner dismissed Appellant’s arguments previously set forth regarding the rejection of claims 17, 19, 21-23 and 31 under 102(e) over Moeller et al. In response to Appellant’s argument that Moeller et al. fails to teach or suggest the use of a first communication interface to enable an inactive option resident on a remote device that is different from a second communication interface for transmitting the code to the device, the Examiner stated that “Moeller teaches a scanner/scanner pc workstation (figure 1, units 10 & 5) that is connected to the remote browser (figure 1, units 70) **via the internet 20 (first communication interface)** and also via a **telephone mode connection 120 (second communication interface that is different from the first communication interface).**” *Examiner’s Answer*, supra at pp. 8-9 (emphasis in original). The Examiner also

stated that “Moeller teaches displaying a GUI (i.e., selection from a menu) configured to facilitate a request over a first communication interface to enable an inactive option resident on a remote device [column 4, lines 3-19, 29-35, lines 63-67 and figure 1] and transmitting the code to the device having the inactive option over a second communication interface different from the first communication interface [column 4, lines 3-19, 41-46, column 5, lines 1-10 and figure 1].” *Id.* at 4. In light of these assertions, the Examiner maintained that Appellant’s interpretation of the system disclosed in Moeller et al. is incorrect. Appellant respectfully disagrees. That is, Appellant believes that the Examiner continues to misinterpret and mischaracterize the teachings of Moeller et al.

The disclosure of Moeller et al. clearly does not teach that which is set forth in claim 17 of the present invention. Claim 17 calls for, in part, a computer data signal process originating from a computer program executed by a computer which, when executed by at least one processor, causes the at least one processor to display a GUI configured to facilitate a request over a first communication interface to enable an inactive option resident on a remote device, cause a remote centralized processing station to generate a code configured to enable the inactive option and transmit the code to the device having the inactive option over a second communication interface different from the first communication interface.

Moeller et al. fails to teach or suggest the use of a first communication interface to enable an inactive option resident on a remote device that is different from a second communication interface for transmitting the code to the device. As Appellant previously set forth, Moeller et al. is directed to a method and system to remotely configure business office devices to user defined parameters. As shown in Fig. 2 of Moeller et al., one embodiment of the invention discloses a method whereby a user can access a list of available features for a scanner through an interface on the scanner to be reconfigured. A user selects the desired soft features 40 for the limited feature scanner 50 by accessing a system configuration port 30 and entering a scanner unit identification number (ID) 170 unique to the user’s limited feature scanner 50. The system configuration port 30 confirms the ID 170 and uploads to the user’s PC 10 those soft features 40 that are currently available. The user then selects those soft features 40 that he wishes to enable or download to his limited feature scanner 50 and transmits a payment 190 for the soft features 40 via a secured internet transaction or other secure means. After payment, the user then receives an access key or access code 140 to enter into the scanner for the scanner to configure itself and enable the features selected, and disabling the unselected features when necessary. *Moeller et al.*, Col. 4, ll. 27-46. The access key 140 is entered into the limited feature scanner 50 either by the user via an alphanumeric keypad on the scanner or via the workstation keypad, or by sending a code or file of

information to be loaded into the PC workstation. The limited feature scanner 50 then configures its soft features 40 in accordance with the access key 140 provided to it by the user. The user can then reconfigure the scanner by repeating the above described steps. *Id.*, Col. 4, ll. 46-58. Thus, in the embodiment shown in Fig. 2 of Moeller et al., both the request and the key transmission are transmitted over the internet or other secure means. There is no disclosure for use of two different communication interfaces.

As a separate embodiment, Moeller et al. discloses that a feature enablement request can be made in a telephonic request initiated by a user. As shown in Fig. 3, Moeller discloses a method whereby a user can make a telephonic request for a feature enablement on the scanner. A user can remotely configure the scanner by telephoning the scanner company, when the user does not have access to a modem or internet connection. In this embodiment, the user calls the scanner company to turn on the desired feature selected from a menu at step 200. The user provides the scanner company with the user's information, the scanner ID number, and the desired features at step 210. In turn, the scanner company gives the user an access code at step 220 which will allow the scanner to configure itself. The customer inputs the access code into the scanner at step 260, and the scanner configures itself or enables the selected menu items, at step 270. *Id.* at Col. 4, ll. 59-67 and Col. 5, ll. 1-11.

The methods set forth in Fig. 2 and Fig. 3 of Moeller et al. are separate embodiments. That is, a user can either make a feature enablement request over the internet or over the telephone. In neither case, however, is the feature enablement request made over a first communication interface and access key or code transmission over a second communications interface that is different from the first communications interface. In the system of Moeller et al., both the request and the key transmission are transmitted over the internet/other secure means, or alternatively, both the request and the key transmission are made over the telephone. There is no disclosure of a use of the two different communication interfaces in conjunction with one another. That is, there is no disclosure or teaching in Moeller et al. that the request can be made over the internet and the key transmission made over the phone, or vice versa. This is in stark contrast to that called for in claim 17, which calls for a first communications interface to facilitate a feature enablement request and a second communications interface to facilitate a key transmission, the second communications interface being different from the first communications interface. Therefore, Moeller et al. cannot anticipate that which is called for in claim 17. As such, claim 17 and the claims that depend therefrom are patentably distinct over the art of record.

III. Rejection Under 35 U.S.C. §103(a) as Being Unpatentable Over Moeller et al. (USP 6,694,384) in View of Appellant's Admitted Prior Art

In paragraph (10) **Response to Argument** of the Examiner's Answer, the Examiner rejected arguments previously set forth by the Appellant regarding the rejection of claims 20 and 24-29 under 103(a) over Moeller et al. in view of Appellant's Admitted Prior Art. In response to Appellant's argument that Moeller et al. fails to teach or suggest communicating a feature request over a public communication connection and communicating a software key over a private communication connection, the Examiner stated that "Moeller teaches a scanner/scanner pc workstation (figure 1, units 10 & 5) that is connected to the remote browser (figure 1, units 70) **via the internet 20 (public communication interface)** and also via a **telephone mode connection 120 (private communication interface)**." *Examiner's Answer*, supra at p. 9 (emphasis in original). The Examiner also stated that "Moeller teaches a software key generation tab, where upon user selection of the software key generation tab transmits a data transmission over a public communication connection to the centralized processing center, and wherein the data transmission represents a request to activate the inactive software program resident in memory of the scanner over a private communication connection." *Id.*

As set forth above with regard to claim 17, in the several embodiments of the system disclosed by Moeller et al., a feature enablement request and a key transmission are made over the same connection – either internet or telephone. As the request and activation performed in claim 24 are made over public and private communication connections respectively, they necessarily are made over two separate connections. Such is not the case in Moeller et al., which clearly fails to teach or suggest communicating a feature request over a public communication connection and communicating a software key over a private communication connection. Rather, Moeller et al. clearly discloses that both the feature enablement request and the software key transmission for configuring an office device are made over the same communication interface. The Examiner has improperly identified two separate communication interfaces in the described embodiments. AAPA also makes no teaching, disclosure, or suggestion of such a public communication interface and private communication interface, as is set forth in detail above. Therefore, the combination of Moeller et al. and AAPA fails to teach, disclose, or suggest all of the elements set forth in claim 24. Thus, claim 24 is patentably distinct over the combination of Moeller et al. and AAPA.

In view of the above remarks, Appellant respectfully submits that the Examiner has provided no supportable position for the rejection of claims 17, 19-29, and 31. Accordingly, Appellant respectfully requests that the Board find claims 17, 19-29, and 31 patentable over the prior art of record and withdraw all outstanding rejections.

Respectfully submitted,

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